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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,483	11/10/2005	Yusuke Suzuki	S1459.70092US00	3894
23628 7590 04/09/2009 WOLF GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210-2206				
EXAMINER				
HENRY, CALEB E				
ART UNIT		PAPER NUMBER		
2894				
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04/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,483

Applicant(s)

SUZUKI ET AL.

Examiner

CALEB HENRY

Art Unit

2894

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 AND 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The claims filed on 02/03/2009 have been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,2,3,5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada (5800631).

Regarding claim 1, Yamada teaches an electrode (205, Fig. 3) comprising a carbon carrying a metal and a binder (col. 25, lines 44-53).

Regarding claim 2, Yamada teaches an electrode (205) which is formed on an electrically conductive substrate (201, Fig. 3) (col. 24, lines 10-42).

Regarding claim 3, Yamada teaches an electrode (205) wherein the electrically conductive substrate (201) is made of glass, a polymer film or a metal (col. 24, lines 10-42).

Regarding claim 5, Yamada teaches an electrode (205) wherein the metal is at least one kind of metal selected from the group consisting of Pt, Ru, Co, Ti, Ni, Al and Au (col. 25, lines 44-53).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada, in view of Ito (US 6475670 B1).

Regarding claim 4, Yamada teaches an electrode comprising a carbon carrying a metal and a binder.

However, Yamada does not disclose the type of carbon utilized (i.e. the carbon is needle-like carbon, fullerene, carbon nano-tube or electrically conductive carbon black).

Ito teaches the use of an electrode wherein the carbon is needle-like carbon, fullerene, carbon nano-tube or electrically conductive carbon black (Ito, col. 3, lines 6-21).

Ito teaches that the formation of "carbon electrodes", of this type, and utilizing such "conductive fine particles" is well known in the art. It is also well known in the art that carbon material is utilized due to its high energy density per unit volume. Also, both Ito and Yamada strive to produce a "carbon electrode".

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Ito to the teachings of Yamada due to aforementioned reasons.

6. Claims 6-8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada.

In regard to Claim 6, Yamada differs from the claimed invention by not showing the specific surface area of the carbon is equal to or larger than $100 \text{ m}^2/\text{g}$. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the electrode to have the specific surface area of the carbon is equal to or larger than $100 \text{ m}^2/\text{g}$, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In regard to Claim 7, Yamada differs from the claimed invention by not showing the specific surface area of the carbon is equal to or larger than $300 \text{ m}^2/\text{g}$. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the electrode top have the specific surface area of the carbon is equal to or larger than $300 \text{ m}^2/\text{g}$, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In regard to Claim 8 Yamada differs from the claimed invention by not showing the amount of the metal carried by the carbon is equal to or more than 5 weight percent of the carbon. It would have been obvious to one having ordinary skill in the art at the time the invention was made for electrode wherein the amount of the metal carried by the carbon is equal to or more than 5 weight percent of the carbon, since it has been

held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

In regard to Claim 18 Yamada differs from the claimed invention by not showing (the amount of metal in the electrode ranges between 5 wt % and 15 wt % relative to the carbon). It would have been obvious to one having ordinary skill in the art at the time the invention was made for (the amount of metal in the electrode ranges between 5 wt % and 15 wt % relative to the carbon), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

7. Claim 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada, in further view of Murofushi (7157788 B2).

Regarding claim 16, Yamada teaches an electrode comprising a carbon carrying a metal and a binder.

However, Yamada does not teach the electrode is disposed immediately adjacent to an electrolytic layer.

Murofushi teaches an the electrode is disposed immediately adjacent to an electrolytic layer (Murofushi, col. 1, lines 29-51).

Murofushi teaches the electrolytic layer acting as an electrochemical contact (Murofushi, col. 1, lines 29-51) and both teachings are related to the same field of endeavor i.e. fabrication of solar cells..

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Murofushi to the teachings of Yamada due to aforementioned reasons.

8. Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada, in view of Yamakawa (US 6656663 B2).

Regarding claim 17, Yamada teaches an electrode comprising a carbon carrying a metal and a binder.

However, Yamada does not teach the binder is insoluble to electrolytes.

Yamakawa teaches the binder is insoluble to electrolytes (Yamakawa, col. 7, lines 62-67).

One with common knowledge in the art would know by having a binder with such properties, this prevents the diffusion of electrolytes, from the electrolytic layer.

Thus it would have been obvious to one of ordinary skill in the art at the time of the invention to append the teachings of Yamakawa to the teachings of Yamada due to aforementioned reasons

Response to Arguments

9. Applicant's arguments filed 02/03/2009 have been fully considered but they are not persuasive. Applicant argues the following:

"Yamada does not disclose a carbon *carrying* a metal *and* a binder. Because each of claims 2-8 depend from independent claim 1, the rejections of these claims should also be withdrawn." - Examiner refers to Yamada, col. 25, line 51 wherein

Yamada teaches the electrically conducting paste can include electrically conductive PASTE(S) Cu, Ni, or Carbon dispersed in a binder. Thus, Yamada does teach this limitation.

All other claims are rejected due to previous rejection and their dependence on Claim 1.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **CALEB HENRY** whose telephone number is (571)270-5370. The examiner can normally be reached on **Monday-Thursday, 7:30 AM- 5:30 PM, ALT. Fridays, Est..**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Kimberly D. Nguyen** can be reached on 571-272-2402. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CALEB HENRY/
Examiner, Art Unit 2894

/THANH V. PHAM/
Primary Examiner, Art Unit 2894